

REMARKS

Claims 1 and 4-21 are now pending. Claims 8 and 19 are amended.

Claim Objection

Claim 8 is objected to because of an informality. Applicant has amended the claim to obviate this objection. Accordingly, Applicant respectfully requests withdrawal of this objection.

35 U.S.C. § 112 Rejections

Claim 19 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended the claims to obviate this rejection. Accordingly, Applicant respectfully requests withdrawal of this rejection.

35 U.S.C. § 103 Rejections**A. Governing Criteria**

For rejections under 35 U.S.C. § 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03.

The Supreme Court set the standard for evaluating obviousness in its recent decision (*KSR International Co. v. Teleflex Inc. et al.* (550 U.S. 127 S. Ct. 1727 (2007))) to be “expansive and flexible” and “functional.” However, the standard is not controlling, rather, the various noted factors only “can” or “might” be indicative of obviousness based on the facts. The Supreme Court in KSR enunciated the following principles:

“[w]hen a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, Section 103 likely bars it patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same

way, using the technique is obvious unless its actual application is beyond his or her skill....[A] court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). The Supreme Court while recognizing the need “to guard against slipping into the use of hindsight,” acknowledged the following principles:

[r]ejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.

Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993). The Supreme Court in *KSR* stated that:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently, known in the prior art.

An examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983), cert. denied, 464 U.S. 1043 (1984); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the

claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. The Supreme Court in *KSR* has also stated that:

[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the market place.

Further, the Supreme Court states that:

The Court relied upon the corollary principle that when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious.

B. Discussion of Rejections

Claims 1, 4-5, 7-13, 15-18, and 20-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Muttik et al. (U.S. Patent No. 6,907,396) and further in view of Brody (U.S. Publication No. 2001/0051928). Applicant respectfully traverses this rejection.

The combination of Muttik and Brody does not teach or suggest the present claims. As stated by the Examiner, Muttik does not disclose all the elements of ensuring security of an open platform computer system as claimed. The Examiner states “[n]ot explicitly disclosed is wherein said method operates on a computer system which comprises a portable computing device coupled to the host computer.” Applicant agrees.

Brody does not cure Muttik’s deficiency. As argued in the previous office action, Brody describes a closed platform that protects the **publisher** from its software being copied and distributed in an unauthorized manner. For example, Fig. 3 discloses a process in which the software publisher is in complete control of the software distribution, including the personalization process.

The Examiner states “Brody teaches a PDA coupled to a host device for personalization purposes. Furthermore, Brody et al. teach[es] that one of the steps during the personalization process may be to scan the software before allowing it to be downloaded to the PDA to prevent from downloading an application with malicious code (para. 105)”. Office Action, p. 5. The Examiner submits as the reasoning for combination that

it would have been obvious to a person in the art at the time of the invention was made to modify the method disclosed in Muttik et al. to have the hand-held device coupled to the host computer in order to carry out different functions on the portable device, where one of the functions includes the PDA have a validation program stored in a secure fashion in order to scan the software. Office Action, p. 5-6.

However, Applicant disagrees. Nowhere in the Examiner’s cite, indeed, **nowhere** in Brody, is it stated that the personalization process **scans any software** before allowing it to be downloaded to a PDA. Furthermore, nowhere in Brody is it disclosed that the hand-held device is performing different functions on the hand-held device. The Examiner’s cite is provided below for convenience:

It should be noted that while a personalization according to the present invention can be authenticated by the use of a digital signature, the goals and processes of applying a personalization are completely distinct from those of authenticating the software itself (such as for Java-based software, as previously discussed, which results in a "signed software application" or "signed archive"). As already detailed, the goal of authenticating software (such as a Java software application or archive) is to protect the user from possibly-malicious effects of untrusted software, and the process of doing so basically involves only the applying of a digital signature to the software and the subsequent validation thereof at run-time, according to well-known methods of public-key cryptography. In contrast, as disclosed herein, the goal of applying a personalization to software, with or without authentication, is to protect the software itself (and the software publisher who developed the software) by affording some degree of protection against unauthorized copying and distribution. Moreover, the processes of applying a personalization, as detailed herein, involve novel methods that are different from the mere application of a digital signature, although digital signatures may be used as part of these processes to protect the applied personalization against tampering and forgeries. Brody, para 105.

Brody clearly states that software can be authenticated according to well-known public key cryptography. This well-known process does not scan any software, but investigates and compares a digital signature to that of a trusted source. Brody makes an assumption that if a

digital signature is from a trusted source, then the software must not be malicious. This is a false assumption as malicious software could have a valid digital signature applied to it to fool this type of system.

Brody then states that the application of its personalization method is more secure than only using digital signatures. This statement is not implying that a host computer is carrying out any functions whatsoever. Brody clearly states that its method affords “some degree of protection against unauthorized copying and distribution.” In other words, Brody has nothing to do with emulation, virus scanning, or other techniques of discovering malicious code.

As such, one of the steps of personalization does not involve scanning software. As argued in the previous response to office action, the use of the phrase “may be to scan...” by the Examiner indicates that the combination comes from the Applicant’s disclose and nothing within Brody.

Furthermore, the Brody cite teaches away from the present invention as claimed. Brody states “the goal of applying a personalization to software, with or without authentication, is to **protect the software itself (and the software publisher who developed the software)** by affording some degree of protection against unauthorized copying and distribution.” This is not “ensuring the security of a computer system” as claimed. Personalization is to ensure that a publisher is able to control the distribution of its software (e.g., gets paid for each downloaded copy). As such, Brody does not provide for validating any software in a secure environment as claimed.

Brody and Muttik, alone or in combination, do not disclose, teach, or suggest each and every element of the claims as required. As argued above, one ordinarily skilled in the art would not look to combine these references because of their quite disparate teachings. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 6, 14, and 19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Muttik et al., in view of Brody as applied to claims 1, 8, & 17, further in view of Ginter et al. (U.S. Patent No. 6,948,070). Applicant respectfully traverses this rejection.

As argued with regard to claims 1, 8, and 18, Muttik and Brody, alone or in combination, do not teach or suggest the present claims. Ginter does not cure the Brody-Muttik combination’s

deficiencies. Ginter is directed towards electronic commerce transactions. Accordingly, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In light of the above remarks, Applicant respectfully requests reconsideration of the rejected claims and solicits their allowance. In the event an interview is useful in resolving any issues, the Examiner is invited to telephone the undersigned representative.

Respectfully submitted,

BERRY & ASSOCIATES P.C.

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